

REMARKS

Claims 1-62 are pending. No amendments have been made by way of the present submission, thus, no new matter has been added.

In view of the following remarks Applicants respectfully request that the Examiner withdraw all rejections and allow the currently pending claims.

Objection to the Specification

The Examiner has asserted that the Amendment filed on August 14, 2002 introduces "new matter" in the specification and is therefore in violation of 35 U.S.C. §132. Applicants respectfully traverse this "objection".

The introduction of the language "alternatively" or "or alternatively" does not alter the scope of the present specification. The Examiner has read this amendment in a vacuum without giving due credit to the entire specification.

For instance, Applicants have simply amended the specification at pages 51 and 52 to indicate that alternative methods of transferring the label exists.

Concerning the amendments to page 51, line 27, which inserted the word "alternatively," and "or alternatively" Applicants were simply attempting to clarify that the heating device may be applied either to the image or non-image side of

the support. For instance, heat may be applied from either the front or the back of the receptor element.

Support for this clarified language may be found at various locations throughout the specification. For instance, Applicants request that the Examiner consult originally filed claim 46. Claim 46 explains that a method for applying an image to a receptor element may comprise the steps of:

- (1) imaging a heat setting label sheet which comprises a support, a pressure sensitive adhesive layer and an adhesion layer or a support, a barrier layer and an adhesion layer; and
- (2) peeling said image and adhesion layer from said support, said peeling occurring without water, heat or chemical aids;
- (3) positioning the adhesion layer against the receptor element; and
- (4) applying heat to the adhesion layer.

In this embodiment of claim 46, which is also supported by the present specification at page 4, the label sheet is first imaged and then the image and adhesion layer are peeled away from the support and then placed, adhesion layer down, against a receptor element (such as a T-shirt). Next, heat is applied to the adhesion layer. Claim 46 and page 4 of the specification do

not describe which side of the adhesion layer the heat is applied to. This is due to the fact that in one embodiment the heat may be applied either to the image side, which is facing out, and in which case it is preferable to place a non-stick sheet between the heat source and the image side. Alternatively, heat may be applied to the non-image side, that is, through the back of the T-shirt and thereby activate the adhesion layer. A review of the entire disclosure at pages 51 and 52, as amended by Applicants, reveals that Applicants are simply attempting to clarify this portion of the specification to reflect the embodiment as outlined in original claim 46 and page 4 of the specification. This is perfectly acceptable practice and does not constitute the addition of new matter.

Accordingly, the Examiner is respectfully requested to withdraw this objection.

Issues Under 35 U.S.C. §112, second paragraph

The Examiner has rejected the language "at least" in claim 1 with respect to the Markush language asserting that it is improper and redundant. Applicants traverse this rejection.

The phrase "at least one" in conjunction with the Markush language indicates that more than one member of the Markush group may be present. Without such language the Markush language could be interpreted as including "only one" rather than "more than

one" member. Accordingly, this language is neither redundant nor improper. Reconsideration and withdrawal of this rejection are respectfully requested.

Issues Under 35 U.S.C. §103(a)

The Examiner continues to reject claims 1-45 and 58-62 under 35 U.S.C. §103(a) as being obvious over Meyer, USP 3,555,739 (hereinafter referred to as Meyer '739) in view of Kronzer, USP 5,798,179 (hereinafter referred to as Kronzer '179). Applicants respectfully traverse this rejection.

First, as previously argued, Applicants again take issue with the Examiner's continued reliance upon "official notice". In the Interview Summary prepared by the Examiner dated June 10, 2003 the Examiner states that references have been provided per previous request and that additional references would be provided upon specific reference request. Applicants disagree with this assertion. The Examiner has never provided such supplemental evidence.

Applicants hereby request that the Examiner provide such references or evidence to support the following official notices:

- (1) Official notice has been taken that "employing additives and emulsion polymer blends with suitable blending ratio are commonly used for polymer property modification, as such it would have been obvious to one

skilled in the art at the time the invention was made to include various additives and/or polymer blends in the formulation, motivated by a desired thermal and physical properties." (Refer to page 6, lines 4-8 of the October 3, 2002 Office Action). Although additives emulsion polymer blends may be known, nothing in the cited references provides motivation to include such ingredients as recited in the present claims. The Examiner is requested to provide a reference which is properly combinable with the art of record.

- (2) The Examiner has taken official notice that "it is common knowledge that acrylic polymer adhesives are suitable for pressure sensitive adhesive applications." (Refer to page 7, lines 17-18 of the October 3, 2002 Office Action). Applicants respectfully request that the Examiner provide a reference with such disclosure.
- (3) The Examiner has taken official notice that "it is common knowledge that a suitable heat-sealable thermoplastic resin for heat transfer or label application would inherently have properties as the instant claimed invention." (Refer to page 8, lines 1-3 of the October 3, 2002 Office Action). Applicants traverse and submit that any number of heat-sealable thermoplastic resins are known. The Examiner bears the

burden of providing evidence that such a resin exists, would be used as currently claimed, and would have the properties as claimed.

Second, regardless of the above, even if the Examiner is correct in each of the assertions above, Applicants submit that the prior art cited by the Examiner, when taken in view of all that is asserted to be common knowledge, fails to render the present claims obvious. This will be explained below.

The Examiner has utilized the primary reference of Meyer '739 and the secondary reference of Kronzer '179. No motivation exists to combine these two references as suggested by the Examiner. That is, the material described in Meyer '739 is completely different from the material described in Kronzer '179. For instance, the material described in Meyer '739 does not include an adhesive layer which is capable of being removed from the support without heat (as currently claimed). This is not surprising, since, Meyer '739 specifically discloses that removing the support is inconsistent with the invention of Meyer '739. In this regard the Examiner is referred to column 1, line 63 to column 2, line 5 of Meyer '739. Applicants have provided this disclosure below for the Examiner's convenience.

The present invention is directed to a label or like marking device which offers substantially all the advantages of heat transfers produced according to the

above-noted patent but which can be more economically produced and which has the further important advantage that the time cycle required for applying or bonding the marking to the article to be marked can in many cases be reduced as compared with the procedure involved in the above-noted patent, while, furthermore, **the step of removing the temporary support can be avoided** which results in a saving of time. (emphasis added).

Moreover, at column 2, lines 14-16 of Meyer '739 it is disclosed that:

With such a marking element the support remains bonded to the surface and carries a marking or decorative pattern on the exposed surface.

Thus, the "cold releasable" adhesives are inconsistent with Meyer '739, since Meyer '739 never intends to remove the support from the article. Accordingly, the limitations of "pressure sensitive adhesive layer" and "adhesion layer" claimed in the present claims, for instance claim 1 are neither suggested nor disclosed with Meyer '739.

Moreover, ignoring the fact that the Examiner has selected elements of Kronzer '179 while ignoring other elements (a procedure improper within the scope of 35 U.S.C. §103(a)), one of ordinary skill in the art would find no motivation to modify Meyer '739 as suggested by the Examiner, since Meyer '739 clearly indicates that the support is to remain bonded to the surface of the article. Thus, the limitation of "wherein the adhesive layer is capable of being removed from the support without heat" is neither suggested nor disclosed by Meyer '739.

Additionally, it would destroy the teachings of Meyer '739 to modify the reference in the way suggested by the Examiner. Specifically, Meyer '739 states at column 2, lines 3-5 that the step of removing the temporary support is to be avoided. Where references expressly teach away from what the PTO contends to be obvious from the references (*In re Grasseli et al.* (CAFC 1983) 713 F.2d 731, 218 USPQ 769) or where the Examiner's proposed modification would render the prior art unsatisfactory for its intended purpose, there is insufficient evidence for combining the references in a 103(a) rejection. *Ex parte Rosenfeld* 130 USPQ 113 (POBA 1961); accord, *In re Gordon*, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

Accordingly, the Examiner has failed to present a valid *prima facie* case of obviousness, thus, this rejection is moot. Reconsideration and withdrawal thereof are respectfully requested.

In the Advisory Action dated April 22, 2003 the Examiner asserts that Applicants have argued the cited references individually. Applicants respectfully disagree with this assertion. As explained above, deficiencies exist in both references, thus, the references, whether taken individually or in combination, fail to render the present claimed subject matter obvious.

Additionally, in the Interview Summary dated June 10, 2003

the Examiner asserts that the "support" of Meyer '739 "is not a release layer and as such is not the same as the instantly claimed invention; instead it is an integral part of the imaging label, i.e., it is simply an additional structure not claimed". Applicants respectfully disagree with the Examiner in this regard.

The support of Meyer '739 corresponds to the support of the present invention. However, they differ in that the support of the present invention is removed, while the support in Meyer '739 remains. Characterization of the support of Meyer '739 as simply "an integral part of the imaging label" is improper, however, if the Examiner asserts that the support of Meyer '739 is simply part of the imaging label, then Meyer '739 lacks a support as claimed. In either instance, the presently claimed subject matter is distinct from Meyer '739, and the secondary reference of Kronzer '179 fails to cure any of these deficiencies. Thus, when the disclosure of both references is taken as a whole, the presently claimed subject matter is non-obvious.

In view of the above, Applicants respectfully request that the Examiner withdraw all rejections and allow the currently pending claims.

If the Examiner has any questions or comments, please contact Craig A. McRobbie, Registration No. 42,874 at the offices of Birch, Stewart, Kolasch & Birch, LLP.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By 

Marc S. Weiner
Reg. No. 32,181

Craig A. McRobbie
Reg. No. 42,874

Post Office Box 747
Falls Church, VA 22040-0747
(703) 205-8000

Con
MSW/CAM/gh